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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,613	09/15/2003	Abdol Hossain Farid	P05562US00	2566

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EXAMINER

KAPUSHOC, STEPHEN THOMAS

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/662,613	FARID ET AL.	
	Examiner	Art Unit	
	Stephen Kapushoc	1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-80 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 11, 14, 20, 28, 34, 39, 67, and 76, drawn to methods for genetically identifying a mouse comprising an A→G mutation at position 3876 in the IGF-1R gene, classified in class 435, subclass 6.
 - II. Claims 12, 15, 21, 29, 33, 38, and 66, drawn to methods for genetically identifying a mouse comprising a G→A mutation at position 331 in the IGF-1R gene, classified in class 435, subclass 6.
 - III. Claims 13, 19, 27, 40, 68, and 77, drawn to methods for genetically identifying a mouse comprising a 12bp deletion mutation at positions 3896-3907 in the IGF-1R gene, classified in class 435, subclass 6.
 - IV. Claim 16, 24, 26, 35, 41, and 74, drawn to methods for genetically identifying a pig comprising a G→A mutation identified as SNP 1772 in the IGF-1R gene, classified in class 435, subclass 6.
 - V. Claims 17, 23, 31, 36, 42, 73, and 79, drawn to methods for genetically identifying a pig comprising a G→C mutation identified as SNP 16i73 in the IGF-1R gene, classified in class 435, subclass 6.
 - VI. Claims 18, 22, 30, 37, 43, 72, 78, drawn to methods for genetically identifying a pig comprising a G→A mutation identified as SNP 16i27 in the IGF-1R gene, classified in class 435, subclass 6.

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- VII. Claims 52-56, drawn to a method for determining the haplotype of a mouse IGF-1R gene comprising both position 331 and position 3896-3907, classified in class 435, subclass 6.
- VIII. Claims 60-62, drawn to methods for genetically identifying a pig comprising a SNP at position 3832 in the IGF-1R gene, classified in class 435, subclass 6.
- IX. Claim 69, drawn to methods for genetically identifying a mouse comprising an insertion of a G nucleotide in intro 16 at position 176 in the IGF-1R gene, classified in class 435, subclass 6.
- X. Claim 80, drawn to a method for genetically identifying cattle by assaying for the presence of a polymorphism in the IGF-1R gene, classified in class 435, subclass 6.

Linking claims

- 2. Claims 65 and 70 link(s) inventions I, II, III, VII, and IX. Claims 64, 71, and 75 link(s) inventions IV, V, VI, and VIII. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 65 and 70, and claims 64, 71, and 75.
- 3. Claims 44 and 51 link(s) inventions I-IX. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 44 and 51.

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4. Claims 1-10, 25-26, 45, 57-59 and 63 link(s) inventions I-X. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-10, 25-26, 45, 57-59 and 63.

5. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104. Claims that require all the limitations of an allowable linking claim will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim(s) including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

6. Inventions I-X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are drawn to the analysis of nucleic acids from different organism (mouse, pig, and cow) as well as nucleic acids that have unique sequences that are not common to one another. The invention comprising the analysis of any one particular single

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polymorphic position does not require the different invention of the analysis of any other distinct position; the inventions have different modes of operations and effects in that they require the analysis of unique sequences (mode of operation) and they lead to the identification of unique sequence content (effect). The search required for the examination of a method drawn to any particular organism, or any particular variant of a gene sequence is not coextensive with the search required for the examination of any other particular organism or variant gene sequence. For example, a reference against a polymorphism at a particular position in a mouse gene would not necessarily be a reference against polymorphisms at any other position in a mouse gene, nor against any polymorphic position in a cow gene. Furthermore, a reference against analysis of a pig gene would not necessarily be a reference against analysis of a homologous gene in cow or mouse.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as demonstrated by their recognized divergent subject matter, and because inventions I-X require different searches that are not coextensive, examination of these claims would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Kapushoc whose telephone number is 571-272-3312. The examiner can normally be reached on Monday through Friday, from 8am until 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached at 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen Kapushoc
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JULIET C. SWITZER
PRIMARY EXAMINER